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REMARKS

The Office action has been carefully considered. The Office action rejected claims 1-12 and 29-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Further, the Office action rejected claims 1, 5, 10, and 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,909,213 to Martin et al. ("Martin"). Further yet, the Office action rejected claims 13, 15, 17, 21-23, 26-28, and 31-32 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application No. 2003/0163525 to Hendriks et al. ("Hendriks"). Still further, the Office action rejected claims 2 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of U.S. Patent Application No. 2004/0201633 A1 to Barsness et al. ("Barsness"). The Office action rejected claims 3 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of U.S. Patent No. 5,859,974 A1 to McArdle et al. ("McArdle"). The Office action rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of McArdle and Barsness. The Office action rejected claims 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of U.S. Patent No. 5,729,687 to Rothrock et al. ("Rothrock"). The Office action rejected claims 14 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Hendriks in view of U.S. Patent Application No. 2002/0042833 A1 to Hendler et al. ("Hendler"). The Office action rejected claims 16, 19, 20, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Hendriks in view of Rothrock. The Office action rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Hendriks in view of U.S. Patent Application No. 2002/0103708 A1 to Kloubakov et al. ("Kloubakov"). The Office

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action rejected claims 24 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Hendriks in view of U.S. Patent No. 6,170,016 B1 to Nakai et al. ("Nakai"). The Office action rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0009459 A1 to Chastain et al. ("Chastain") in view of U.S. Patent Application No. 2004/0163042 A1 to Altman et al. ("Altman"). Finally, the Office action rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Chastain in view of Altman and in further view of U.S. Patent Application No. 2002/0042830 A1 to Bose et al. ("Bose").

In addition to the exhaustive listing of various references under which the claims have been rejected on the art, the Office action objects to claims 9, 11, and 29-30 for various informalities under §112, second paragraph. These claims have been amended to overcome the objections. Regarding the rejections detailed above, applicants respectfully disagree.

By present amendment, claims 1, 9, 11, 13, 29, and 31 have been amended for clarification and not in view of the prior art. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Applicants thank the Examiner for the interview held (by telephone) on May 15, 2006. During the interview, the Examiner and applicants' attorney discussed

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the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is directed to a system and method in a computing environment in which computer users are able to make their handwritten annotations public to other computer users, as well as to view notes from other computer users who have chosen to make their notes public. Users can selectively publish (e.g., identify as being public annotations) specific authored notes, and subscribe to other's published notes. A computer user that has made his or her notes public is also able to determine who is subscribing to those notes.

In one embodiment, a computer user may run a program such as on a tablet-based personal computer, and may enter a publication mode, presented to the user as a public data entry area. In this mode, ink strokes are sent to a server, which records the ink strokes in association with the user's identity, and with the current context of those notes, such as a page (e.g., slide) of a publication (e.g., a PowerPoint presentation). The server also tracks what other users have subscribed to public notes corresponding to that identity.

In one implementation, while a user is in the publishing mode, a background thread executing on the user's computer may operate to send the stroke data to the server, essentially as it is being entered. A separate background thread may

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communicate with the server to receive and provide the public stroke data of other users to which the computer user has subscribed.

The present invention also facilitates other useful applications, including a mode that provides a wholly public persistent space which any computer user can annotate, referred to as a shared canvas. For example, such a space is highly useful in an environment having audience members and speakers, such as to make background comments, project this "canvas" for those present to view a spontaneous sketch or diagram, collect points of view for an informal poll, and so forth. The space is tied to a publication page being presented, such as a slide of a slide show presentation, and typically controlled by one individual, generally the one making the presentation. Another mode provides a graffiti-type wall in which users can add any annotations, independent of any page.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

§112 Rejections

The Office action rejected claims 29-30 for failing to particularly point and distinguish subject matter that is the invention. Applicants respectfully disagree. Notwithstanding, claim 29 has been amended to recite language to make the scope of the claim more clear and has been done so in an effort to more particularly point out and distinctly claim that which the applicants regard as their invention. Applicants submit that the amendments to claim 29 overcome the §112 rejection and request that the §112 rejections for claims 29-30 be withdrawn.

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§101 Rejections

The Office action rejected claims 1-12 and 29-30 as being directed to non-statutory subject matter. More specifically, the Office action contends that the language, "the data is deemed public" in claim 1 is based on subjective criteria and therefore not statutory. Further, the Office action contends that claims 12 and 29 recite a computer-readable medium that may incorporate a carrier wave which the Office action contends is not statutory subject matter. Applicants respectfully disagree.

Section 2106(IV)(B)(1)(a) of the MPEP states that functional descriptive material that is recorded on some computer-readable medium is structurally and functionally interrelated to the medium and is statutory since use of technology permits the function of the descriptive material to be realized. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *In re Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim). Carrier waves and modulated signals are examples of data that may be interpreted by a computer (*i.e.*, a computer-readable medium) and may also be considered a product-by-process which is also statutory per se if the underlying process is statutory. Furthermore, the MPEP specifically states (section 2106(IV)(B)(1)(c)) that a signal claim directed to a practical application is statutory regardless of its transitory nature. See *O'Reilly*, 56 U.S. at

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114-19; *In re Breslow*, 616 F.2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980). Recent court decisions have also held that "signals" are proper statutory subject matter. See *Arrhythmia Research Technology, Inc. v. Corazonix Corp.*, 958 F.2d 1053, 22 USPQ.2d 1033 (CCPA 1992), (wherein the court held that the view that there is nothing necessarily physical about "signals" is incorrect and that computer-program related inventions can be claimed in terms of "signals" as computers operate according to signals. In fact, anything that is being manipulated or transformed can typically be drafted in terms of "signals").

Notwithstanding the preceding, applicants have amended claim 1 to eliminate the language "the data is deemed public" in an effort to more particular point out and distinctly claim that which the applicants regard as their invention. Furthermore, claims 12 and 29 have been amended to recite a computer-readable storage medium that clearly falls within statutory subject matter. As such, applicants respectfully request that the §101 rejections of these claims be withdrawn.

§102 Rejections

Turning to the rejections on the art, amended claim 1 generally recites in a computing environment, a method comprising receiving handwritten annotation data of an author, the annotation data identified as public data and automatically sent from an author's device for publishing, and distributing the annotation data to at least one device of at least one recipient subscriber.

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The Office action rejected claim 1 as being anticipated by Martin. More specifically, the Office action contends that Martin teaches receiving annotation data of an author that is deemed public and automatically sent from an author's device for publishing. Column 1, lines 44-61 and column 5, lines 1-10 and 40-48 of Martin are referenced. Further, the Office action contends that Martin teaches distributing the annotation data to at least one device of at least one recipient subscriber. Column 5, lines 7-11 and 46-48 of Martin are referenced. Applicants respectfully disagree.

Martin is directed toward a system for allowing users of networked computers to electronically highlight selections of an electronic document. Further, users are then able to share the highlighted information with other connected computer systems. Martin, however, may only use specific tools in a toolbar to affect electronic documents, *i.e.*, highlighting. The Office action acknowledges this fact in stating that Martin does not teach any recognition of handwriting or handwritten strokes (see §103 rejection of claim 2). Claim 1 has been amended to recite receiving handwritten annotation data and this is clearly a concept that is not taught by Martin as expressly acknowledged by the Office action. For at least this reason, applicants submit that claim 1 is allowable over Martin.

Applicants respectfully submit that dependent claims 5, 10 and 12, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, Martin fails to disclose the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. In addition to the

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recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, amended claim 13 generally recites a system comprising an annotation device that is a client of the server, the annotation device including an annotations program that manages ink annotations input by an author and includes at least one operating mode in which the input ink annotations are to be published, and a send mechanism that sends the published ink annotations to a server for distribution to other clients, the published ink annotations identified as public and selectively published to at least one client and not published to at least one other client.

The Office action rejected claim 13 as being anticipated by Hendriks. More specifically, the Office action contends that Hendriks teaches an annotation device that is a client of the server, the annotation device including an annotations program that manages ink annotations input by an author and includes at least one operating mode in which the input ink annotations are to be published. Fig. 3 and paragraphs 0032 and 0038 of Hendriks is referenced. Further, the Office action contends that Hendriks teaches a send mechanism that sends the published ink annotations to a server for distribution to other clients. Fig. 3 and paragraph 0035 of Hendriks are referenced. Applicants respectfully disagree.

Hendriks is directed to a device that is operable to handle the input of annotation data from a user. The annotation data may be handwritten strokes and/or keyed/typed input. Once a user has entered the annotation data in a specified field for publication, a send button allows the user to publish the data to

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all connected users. However, the system of Hendriks cannot distinguish among the connected users such that any annotation data that is published will necessarily be sent to each and every client connected to the network of users.

In contrast, claim 13 recites selectively publishing annotation data to at least one client and not publishing to at least one other client. That is, a user may selectively publish annotation data amongst specific users of the network. In this manner, annotation data may be published to a subgroup of network clients while simultaneously being excluded from another subgroup of network clients. The system of Hendriks cannot distinguish between different network clients in this manner, as any published data will necessarily be sent to all connected devices.

Furthermore, claim 13 recites identifying annotation data as public. That is, the annotation data itself is identified as public and may be persisted as public data (carrying publication data for specific users and not for others). Quite differently, Hendriks merely publishes *anything* that is input into a public field on the originating device. Thus, Hendriks publishes data based on the location of its input and not based on a designation of the data itself as public.

For at least the foregoing reasons, applicants submit that claim 13 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 15, 17, 21-23, and 26-28, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 13 and consequently includes the recitations of independent claim 13. As discussed above, Martin fails to disclose the recitations of claim 13 and therefore these claims are also allowable over the prior art of record. In

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addition to the recitations of claim 13 noted above, each of these dependent claims includes additional patentable elements.

Turning to the last independent claim rejected under §102, amended claim 31 generally recites in a computer network, a system comprising a first annotation device having a first annotation program thereon on which an author inputs annotation data, the annotation data input by the author identified as public and selectively published to at least one client and not published to at least one other client, a second annotation device having a second annotation program thereon which outputs annotation data, and a server that receives the public annotation data from the first annotation device and sends the public annotation data to the second annotation device for output via the second annotation program.

The Office action rejected claim 31 as being anticipated by Hendriks. More specifically, the Office action contends that Hendriks teaches a first annotation device having a first annotation program thereon on which an author inputs public annotation data. Fig. 3 and paragraphs 0032 and 0038 of Hendriks are referenced. Further, the Office action contends that Hendriks teaches a second annotation device having a second annotation program thereon which outputs annotation data. Fig. 3 and paragraphs 0032 and 0035 of Hendriks are referenced. Finally, the Office action contends that Hendriks teaches a server that receives the public annotation data from the first annotation device and sends the public annotation data to the second annotation device for output via the second annotation program. Fig. 3 and paragraph 0035 of Hendriks are referenced. Applicants respectfully disagree.

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As discussed above, Hendriks is directed to a device that is operable to handle the input of annotation data from a user wherein annotation data may be handwritten strokes and/or keyed/typed input. Once a user has entered the annotation data into a specified field for publication, activation of a send button publishes the data to all connected users. Quite different from the present invention, however, the system of Hendriks cannot selectively distinguish among the connected users to the point that any annotation data that is published will necessarily be sent to each and every client connected to the network of users.

In contrast, claim 31 recites selectively publishing annotation data to at least one client and not publishing to at least one other client. That is, a user may selectively publish annotation data amongst specific clients of the network. In this manner, annotation data may be published to a subgroup of network users/machines while simultaneously being excluded from another subgroup of network users/machines. The system of Hendriks cannot distinguish between different network clients in this manner as any published data will necessarily be sent to all connected devices.

Furthermore, claim 31 recites identifying annotation data as public. That is, the annotation data itself is identified as public and may be persisted as public data (carrying publication data for specific users and not for others.) Quite differently, Hendriks merely publishes anything that is input into a public field on the original device. Thus, Hendriks publishes data based on the location of its input and not based on a public designation of the data itself.

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For at least the foregoing reasons, applicants submit that claim 31 is allowable over the prior art of record.

Applicants respectfully submit that dependent claim 32, by similar analysis, is allowable. This claim depends directly from claim 31 and consequently includes the recitations of independent claim 31. As discussed above, Martin fails to disclose the recitations of claim 31 and therefore this claim is also allowable over the prior art of record. In addition to the recitations of claim 31 noted above, claim 32 includes additional patentable elements.

§103 Rejections

The Office action rejected claims 2-4, 6-9, and 11 as being unpatentable over Martin in view of one or more of the references including Barsness, McArdle, and Rothrock. Applicants respectfully disagree.

To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and "all words in a claim must be considered in judging the patentability of that claim against the prior art;" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

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Applicants submit that the Office action has failed to establish a *prima facie* case for obviousness. Applicants respectfully submit that dependent claims 2-4, 6-9, and 11 are allowable by similar analysis to claim 1 as discussed above. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, Martin fails to disclose the recitations of claim 1. Furthermore, Martin, whether considered individually or in any permissible combination with any prior art of record, including Barsness, McArdle and/or Rothrack, still fails to teach or suggest the recitations of these claims and therefore these claims are also allowable over the prior art of record; none of these references make up for the deficiencies of Martin. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

The Office action rejected claims 14, 16, 18-20, 24-25, and 33-34 as being unpatentable over Hendriks in view of one or more of the references including Hendler, Rothrack, Kloubakov, and Nakai. Applicants respectfully disagree.

Applicants submit that the Office action has failed to establish a *prima facie* case for obviousness. Applicants respectfully submit that dependent claims 14, 16, 18-20, 24-25, and 33-34 are allowable by similar analysis to claims 13 and 31 as discussed above. Each of these claims depends either directly or indirectly from claims 13 and 31 and consequently includes the recitations of these independent claims. As discussed above, Hendriks fails to disclose the recitations of claims 13 and 31. Furthermore, Hendriks, whether considered individually or in any permissible combination with any prior art of record, including Hendler, Rothrack,

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Kloubakov, and/or Nakai, still fails to teach or suggest the recitations of these claims and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claims 13 and 31 noted above, each of these dependent claims includes additional patentable elements.

Turning to claim 29, claim 29 generally recites a computer-readable storage medium having stored thereon at least one data structure, comprising a first set of data representative of authors of published annotations, a second set of data corresponding to each author and corresponding to each author's respective published annotation data of that author, and wherein a request directed towards retrieving the published annotation data of a selected author represented in the first set of data is accessed from the second set of data corresponding to the selected author.

The Office action rejected claim 29 as being unpatentable over Chastain in view of Altman. More specifically, the Office action contends that Chastain teaches a first set of data representative of authors of published annotations. Fig. 7, boxes 740 and 750 and paragraph 0041 of Chastain are referenced. Further, the Office action contends that Chastain teaches that a request directed towards the published annotation data of a selected author represented in the first set of data is accessed from the second set of data corresponding to the selected author. Fig. 7, boxes 740 and 750 and paragraph 0041 of Chastain are again referenced.

The Office action correctly acknowledges that Chastain does not teach a second set of data for each author and corresponding to the published annotation data of that author. However, the Office action contends that Altman does teach

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this recitation and references Fig. 6 and paragraph 0042 of Altman. The Office action concludes that it would have been obvious for a person skilled in the art at the time the invention was made to have combined the teachings of Chastain with the teachings of Altman to arrive at the claim language of claim 29. The Office action contends the reasoning for this combination would allow a user to view annotations based on a particular page and a particular author. Applicants respectfully disagree.

As detailed above, to establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and "all words in a claim must be considered in judging the patentability of that claim against the prior art;" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

Applicants submit that the Office action has failed to establish a *prima facie* case for obviousness. Chastain is directed towards a system for sharing document highlights among electronic documents of an electronic book. In this manner, an author may share book highlights with a group of recipients. As correctly acknowledged by the Office action however, Chastain does not teach a system

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wherein authors may store d ta that corresponds to their own respective annotations about a specific document or set of documents.

Altman, does not cure this deficiency, despite the contention in the Office action. Altman, teaches a system for storing annotations with an original document such that a retrieval of the document may also retrieve each annotation stored therewith. However, Altman does not store any information regarding the author of the document. Despite the Office action referencing a "Creator" in Altman, this term simply does not appear anywhere in Altman, nor is it even suggested. Thus, Altman simply does not teach that which the Office action contends.

Furthermore, the reasons given for the combination of these references is highly suspect at best. Neither Chastain, nor Altman teaches storing author data with annotation data in a database such that this information may be retrieved quickly and easily. In fact, each of these references teaches away from using any kind of authoring data, as each one is wholly concerned with storing a retrievable version of annotation data based upon the document in which the data corresponds. Showing prior art that teaches a first and second set of data that stores the exact same information does not teach the first and second data stores as recited in claim 29. Not only do these two prior art references fail to teach all of the recitations of claim 29, (or dependent claim 30), but these references may also not be permissibly combined in the manner suggested by the Office action. Thus, applicants submit that claim 29 and dependent claim 30 are allowable over the prior art of record for at least the foregoing reasons.

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For at least these additional reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and timely allowance of this application is earnestly solicited.

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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-34 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Amendment, along with transmittal and facsimile cover sheet, are being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. 1.6(d) on the date shown below:

Date: June 29, 2006



Albert S. Michalik

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